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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,172	11/14/2001	Nicholas F. Baida	GK-BAIDA-102/500764.20002	6892

26418 7590 12/29/2003

REED SMITH, LLP  
ATTN: PATENT RECORDS DEPARTMENT  
599 LEXINGTON AVENUE, 29TH FLOOR  
NEW YORK, NY 10022-7650

EXAMINER
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HOOLAHAN, AMANDA J

ART UNIT	PAPER NUMBER
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2859

DATE MAILED: 12/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/992,172

### Applicant(s)

BAIDA, NICHOLAS F.

### Examiner

Amanda J Hoolahan

### Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 6, 7, 11-12, and 14 are rejected under 35 U.S.C. 102(b) as being unpatentable by USPN 6,178,655 to Potter.

Potter discloses a tape measure (15) in a case (80); an indicator window (column 6, lines 46-47) located proximate to a tape measure (40) and having an indication mark (30) positioned to be in line with measurement increments (130) arranged on said tape measure; a retractable cutting blade (90, 100) located inside said case and aligned with the indication mark in the window so as to allow marking of or making of a cut on an object at the measurement increment that is in line with the indication mark using one and only one hand; a marker (60) attached to at least one of said shells and aligned with the indication mark in the window so as to allow marking of an object at the measurement increment that is in line with the indication mark using one and only one hand; said indication mark includes an index line positioned to be in line with said measurement increments (see Figure 2); normal use of the device disclosed by Potter includes the method of making precise measured cuts or marks on objects comprising the steps of measuring a distance using a combination tool comprising a tape measure in a case, an indicator window located proximate to said case and having an indication mark positioned to be in line with measuring increments arranged on said tape measure, and a marker attached to said

case and aligned with the indication mark in the window so as to allow marking or cutting of the object at the measurement increment that is in line with the indication mark; viewing through the indicator window and lining up said measurement increment of said tape measure with the indication mark in the indicator window; marking or cutting the object with said marker that is aligned with the indication mark using one and only hand; wherein said marker is a retractable marker and the step of marking or cutting includes making a measurement mark said retractable marker with the indication mark.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,178,655 to Potter et al. [hereinafter Potter] in view of USPN 4,649,649 to Fain.

Potter discloses the device as described above in paragraph 2 including a shell casing for enclosing a tape measure comprising an indicator window (column 6, lines 46-47) located proximate to a tape measure (40) and having an indication mark (30) positioned to be in line with measurement increments (130) arranged on said tape measure; a marker (60) attached to at least one of said shells and aligned with the indication mark in the window so as to allow marking of an object at the measurement increment that is in line with the indication mark using one and only one hand; a blade (column 14, lines 15-16) connected to at least one of said shells aligned

with the indication mark; a retractable (90, 100) blade molded into at least one of said shells; the marker is a lead pencil (column 15, lines 52-54) connected to at least one of said shells.

Potter does not disclose the device having a first concave shell; a second shell; and an attachment element that attaches said first concave shell to said second shell thereby enclosing the tape measure.

Fain discloses a device comprising a first concave shell (10); a second shell (12); and an attachment element (column 2, line 46, screws (not shown)) that attaches said first concave shell to said second shell thereby enclosing the tape measure. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the tape measure, disclosed by Potter, with the tape measure having separate shells, as taught by Fain, in order for the user to be able to easily take apart the shells if a part needs to be replaced.

5. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potter and Fain as applied to claims 1 and 2, respectively, above, and further in view of USPN 6, 513, 261 to Johnson.

Potter and Fain disclose the device as described above in paragraph 4.

Potter and Fain do not disclose the device having a retractable blade molded into at least one of said shells wherein said retractable blade is molded flush within said shell; the marker being a retractable lead pencil blade molded into at least one of said shells wherein said retractable lead pencil is molded flush within said shell.

Johnson discloses a device having a retractable blade (5) or a retractable pencil (27) molded into at least one of said shells (1) wherein said retractable blade is molded flush within

said shell. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the blade, disclosed by Potter and Fain, with the retractable blade or a retractable pencil molded within a shell, as taught by Johnson, for storage and safety reasons when not in use.

6. Claims 8, 9, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potter in view of USPN 5,430,952 to Betts

Potter discloses the device as described above in paragraph 2 including said marker being adapted to used interchangeable leads or limestone (column 15, lines 52-57).

Potter does not disclose the tape measure including a nail hole at its exposed end.

With respect to claims 8 and 9: Betts discloses a tape measure having a nail hole (31) at its exposed end. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the nail hole, as taught by Betts, to the end of the tape, disclosed by Potter, in order for the user to be able to hold the tape stationary.

With respect to claim 15: Normal use of the device disclosed by Potter and Betts, as described above, comprise the method step of including a nail hole in said tape measure at an exposed end; inserting a nail through said nail hole into the object; and rotating said case about the nail in arc to make a circular measured cut in the object (see Potter, Figure 3).

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Potter in view of USPN 6,309,129 to Kageyama.

Potter discloses the device as described above in paragraph 2.

Potter does not disclose the device wherein the marker is a mechanical lead pencil molded into said case in a flush manner.

Kageyama discloses marker that is a mechanical lead pencil. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the marker, disclosed by Potter, with a mechanical lead pencil, disclosed by Kageyama, in order for the user to be able to refill the marking piece more simply.

#### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-12 and 14-15 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

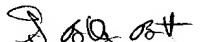
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda J Hoolahan whose telephone number is (703) 308-0139. The examiner can normally be reached on Monday through Friday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F Gutierrez can be reached on (703) 308-3875. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

ajh  
December 17, 2003

Diego Gutierrez  
Supervisory Patent Examiner  
Technology Center 2800

  
**G. BRADLEY BENNETT**  
**PRIMARY EXAMINER**  
AV 2859